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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/722,519	11/28/2000	John S. Hendricks	3960.D10	6858

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EXAMINER

CHAI, LONGBIT

ART UNIT	PAPER NUMBER
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2131

DATE MAILED: 08/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/722,519	Applicant(s) HENDRICKS, JOHN S.	
	Examiner Longbit Chai	Art Unit 2131	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 November 2000 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

1. Applicant's claim for benefit of Continuing Application priority date under 35 U.S.C. 120 is acknowledged.
2. The application is filed on 11/28/2000 but claims the benefit of U.S. Continuing Application number 09/237,825 filed on 01/27/1999, which is a Divisional Application number 08/336,247 (now Patent Number 5,986,690) filed on 11/07/1994.
3. Therefore, the effective filing date for the subject matter defined in the pending claims in this application is 11/07/1994.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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1. Claims 1, 11, 13, 14, and 17 – 20 are rejected under 35 U.S.C. 102(b) as being anticipated by MacPhail (Patent Number: 5089956), hereinafter referred to as MacPhail.

2. As per claim 1, MacPhail teaches a method of communicating between components of a home subsystem for processing electronic books, the method comprising:

- a. sending data text related to an electronic book from a library to a viewer (MacPhail: see for example, Column 4 Line 58 – 64, Column 2, 60 – 64, and Column 1 Line 38 – 49);
- b. comparing a viewer identifier associated with the viewer with a data identifier associated with the data text (MacPhail: see for example, Column 2, 60 – 64); and
- c. if the viewer identifier matches the data identifier, storing the data text in the viewer (MacPhail: see for example, Column 2, 60 – 64).

3. As per claim 13, MacPhail teaches a method for processing text data for an electronic book comprising:

- a. receiving a packet of text data; determining whether the packet has a unique packet identifier (MacPhail: see for example, Column 1 Line 38 – 42, Column 4 Line 26 – 31: MacPhail discloses the electronic document networking techniques); and
- b. if the packet has a unique packet identifier, determining whether the packet identifier matches a library identifier of a library (MacPhail: see for example, Column 1

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Line 38 – 42, Column 4 Line 26 – 31: MacPhail discloses the electronic document networking techniques); and

c. if the packet identifier matches the library identifier, storing the packet to a data file in a library storage (MacPhail: see for example, Column 4 Line 26 – 44, Column 1 Line 38 – 49, Column 4 Line 58 – 66, Column 4 Line 40 – 45).

4. As per claim 11, MacPhail teaches the claimed invention as described above (see claim 1). MacPhail further teaches the data text is transmitted as a digital bit stream (MacPhail: see for example, Column 4 Line 58 – 64, Column 2, 60 – 64, and Column 1 Line 38 – 49).

5. As per claim 14, MacPhail teaches the claimed invention as described above (see claim 13). MacPhail further teaches the packet is received by the library (MacPhail: see for example, Column 4 Line 58 – 64, Column 2, 60 – 64, and Column 1 Line 38 – 49).

6. As per claim 17, MacPhail teaches the claimed invention as described above (see claim 13). MacPhail further teaches the step of storing comprises:

a. determining whether the data file has been opened (MacPhail: see for example, Column 1 Line 38 – 50, Column 1 Line 50 – 52 and Column 1 Line 61 – 65: The data file must be opened before the data can be stored from the packet) , and

b. if the data file has been not been opened, opening the data file; and storing the packet to the data file (MacPhail: see for example, Column 1 Line 38 – 50; Column 1

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Line 50 – 52 and Column 1 Line 61 – 65: The data file must be opened before the data can be stored from the packet).

7. As per claim 18, MacPhail teaches the claimed invention as described above (see claim 17). MacPhail further teaches:

a. determining whether the packet is a final packet received for an electronic book (MacPhail: see for example, Column 1 Line 38 – 50, Column 1 Line 50 – 52 and Column 1 Line 61 – 65: The data file must be closed after the data written has been completed),

b. if the packet is the final packet, closing the data file; and updating a directory (MacPhail: see for example, Column 1 Line 38 – 50, Column 1 Line 50 – 52 and Column 1 Line 61 – 65: The data file must be closed after the data written has been completed).

8. As per claim 19, MacPhail teaches the claimed invention as described above (see claim 13). MacPhail further teaches sending the data file to a viewer (MacPhail: see for example, Column 2 Line 60 – 64).

9. As per claim 20, MacPhail teaches the claimed invention as described above (see claim 19). MacPhail further teaches encrypting and compressing the data file (MacPhail: see for example, Column 6 Line 15 – 17).

10. Claims 21 – 26 are rejected under 35 U.S.C. 102(e) as being anticipated by Choudhury (Patent Number: 5509074), hereinafter referred to as Choudhury.

11. As per claim 21, Choudhury teaches a method for processing data text for electronic books comprising:

- a. sending a packet of data text from a remote operations center to a library (Choudhury: see for example, Column 1 Line 37 and Figure 1 Element 3 discloses the electronic document networking techniques. Copyright Server and Document Server are qualified to serve as the remote operations center and the document library respectively. The user is qualified as a viewer. The necessity of networking techniques, shown in Figure 1, depends upon the close physical proximity between the source and destination entities);
- b. encrypting and compressing the packet (Choudhury: see for example, Column 1 Line 43 – 61);
- c. sending the packet to a viewer communicatively coupled to the library (Choudhury: see for example, Column 1 Line 43 – 61);
- d. storing the packet in a viewer storage (Choudhury: see for example, Column 1 Line 43 – 61);
- d. decompressing and decrypting the packet (Choudhury: see for example, Column 6 Line 15 – 17); and
- e. displaying the data text on a display of the viewer (Choudhury: see for example, Column 6 Line 15 – 17).

12. As per claim 22, Choudhury teaches the claimed invention as described above (see claim 21). Choudhury further teaches storing the packet to a data file in the library, which data file is capable of storing a plurality of packets related to an electronic book (Choudhury: see for example, Column 1 Line 43 – 61).

13. As per claim 23, Choudhury teaches the claimed invention as described above (see claim 22). Choudhury further teaches the step of encrypting and compressing the packet comprises encrypting and compressing the data file, and wherein the step of sending the packet to the viewer comprises sending the data file to the viewer (Choudhury: see for example, Column 1 Line 43 – 61).

14. As per claim 24, Choudhury teaches the claimed invention as described above (see claim 21). Choudhury further teaches the data packet is sent in a bit stream having a packet identifier, and further comprising comparing a packet identifier with a library identifier, and wherein the step of sending the packet to the library comprises sending the packet to the library if the packet identifier matches the library identifier (Choudhury: see for example, Column 1 Line 43 – 61).

15. As per claim 25, Choudhury teaches the claimed invention as described above (see claim 24). Choudhury further teaches the step of decompressing and decrypting the data file comprises using a security key unique to the viewer (Choudhury: see for example, Column 1 Line 46).

16. As per claim 26, Choudhury teaches the claimed invention as described above (see claim 21). Choudhury further teaches the step of decompressing and decrypting

comprises decompressing and decrypting a page of an electronic book at a time, as the page is displayed on the display (Choudhury: see for example, Column 3 Line 44, Column 4 Line 25 – 31 and Column 4 Line 32).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claims 2 – 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over MacPhail (Patent Number: 5089956), hereinafter referred to as MacPhail, in view of Choudhury (Patent Number: 5509074), hereinafter referred to as Choudhury.

18. As per claim 2, MacPhail teaches the claimed invention as described above (see claim 1). MacPhail does not teach encrypting the data text.

19. Choudhury teaches encrypting the data text (Choudhury: see for example, Column 2 Line 62 – 64).

20. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Choudhury within the system of MacPhail because Choudhury teaches a method of protecting electronically published documents which enhances the security on MacPhail system (Choudhury: see for example, Column 1 Line 35 – 40).

21. As per claim 3 and 6, MacPhail as modified teaches the claimed invention as described above (see claim 2 and 5 respectively). MacPhail as modified further teaches preventing the viewer from outputting decrypted data text (Choudhury: see for example, Column 3 Line 10 – 11 and Column 4 Line 31 – 32).

22. As per claim 4 and 7, MacPhail as modified teaches the claimed invention as described above (see claim 2 and 5 respectively). MacPhail as modified further teaches displaying the data text on a display portion of the viewer; and decrypting the data text as the data text is displayed (Choudhury: see for example, Column 6 Line 15 – 17).

23. As per claim 5, MacPhail teaches the claimed invention as described above (see claim 1). MacPhail does not teach preventing the viewer from outputting decompressed data text.

24. Choudhury teaches preventing the viewer from outputting decompressed data text (Choudhury: see for example, Column 6 Line 15 – 17).

25. Same rationale of combination applies here as above in rejecting the claim 2.

26. As per claim 8, MacPhail teaches the claimed invention as described above (see claim 1). MacPhail does not teach the data text is encrypted and compressed when it is received by the viewer, and further comprising decompressing and decrypting a portion of the data text.

27. Choudhury teaches the data text is encrypted and compressed when it is received by the viewer, and further comprising decompressing and decrypting a portion of the data text (Choudhury: see for example, Column 6 Line 15 – 17).

28. Same rationale of combination applies here as above in rejecting the claim 2.

29. As per claim 9, MacPhail teaches the claimed invention as described above (see claim 1). MacPhail does not teach encrypting and compressing the data text before it is sent to the viewer, and further comprising decompressing and decrypting the data text one page at a time, as a current page is displayed on the viewer.

30. Choudhury teaches encrypting and compressing the data text before it is sent to the viewer, and further comprising decompressing and decrypting the data text one page at a time, as a current page is displayed on the viewer (Choudhury: see for example, Column 6 Line 15 – 17).

31. Same rationale of combination applies here as above in rejecting the claim 2.

32. As per claim 10, MacPhail teaches the claimed invention as described above (see claim 1). MacPhail does not teach the viewer has a unique key for decrypting the data text, whereby only one viewer can access a particular transmission of data text.

33. Choudhury teaches the viewer has a unique key for decrypting the data text, whereby only one viewer can access a particular transmission of data text (Choudhury: see for example, Column 1 Line 46 – 61).

34. Same rationale of combination applies here as above in rejecting the claim 2.

35. Claims 12 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over MacPhail (Patent Number: 5089956), hereinafter referred to as MacPhail, in view of Boulton (Patent Number: 4985697), hereinafter referred to as Boulton.

36. As per claim 12, MacPhail teaches the claimed invention as described above (see claim 1). MacPhail does not teach the data text is transmitted from a remote cable headend to the library and bundled into a data file, which data file is sent to the viewer.

37. Boulton teaches the data text is transmitted from a remote cable headend to the library and bundled into a data file, which data file is sent to the viewer (Boulton: see for example, Column 10 Line 63 – 65).

38. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Boulton within the system of MacPhail because Boulton teaches a cable TV transmission technique for electronic book applications.

39. As per claim 15, MacPhail teaches the claimed invention as described above (see claim 14). MacPhail does not teach the packet is transmitted as a digital bit stream from a remote cable headend to the library.

40. Boulton teaches the packet is transmitted as a digital bit stream from a remote cable headend to the library (Boulton: see for example, Column 10 Line 63 – 65).

41. Same rationale of combination applies here as above in rejecting the claim 12.

42. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over MacPhail (Patent Number: 5089956), hereinafter referred to as MacPhail, in view of Feigenbaum (Patent Number: 4644470), hereinafter referred to as Feigenbaum.

43. As per claim 16, MacPhail teaches the claimed invention as described above (see claim 13). MacPhail does not teach if the packet does not have a unique packet identifier, storing the packet to an electronic message file.

44. Feigenbaum teaches if the packet does not have a unique packet identifier, storing the packet to an electronic message file (Feigenbaum: see for example, Column 4 Line 45).

45. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Feigenbaum within the system of MacPhail because Feigenbaum teaches a method of allowing data processing systems to adopt names on either a unique or non-unique basis, which would in effect be transparent to the user if it is a non-unique name for broadcast messages (Feigenbaum: see for example, Column 2 Line 21 – 24 and Column 2 Line 13 – 15).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Longbit Chai whose telephone number is 703-305-0710. The examiner can normally be reached on Monday-Friday 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz R Sheikh can be reached on 703-305-9648. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Longbit Chai
Examiner
Art Unit 2131

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A/U 2136